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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/762,774 | 01/23/2004 | Michael W. Hicok | 1040 | 6126 |
| 7590 04/27/2005 Donald A. Kettlestrings, Esq. Suite 211 414 Hungerford Drive Rockville, MD 20850 | | | EXAMINER LUGO, CARLOS | |
| | | | ART UNIT 3676 | PAPER NUMBER |

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|-----------------------------------|--|
| Office Action Summary | Application No. 10/762,774 | Applicant(s) HICOK, MICHAEL W. | |
| | Examiner Carlos Lugo | Art Unit 3676 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,9,10,15 and 17-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7,8,11-14,16 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17 and 23, drawn to a system for holding together first and second objects, classified in class 292, subclass 240.
- II. Claims 18-22, drawn to a fastener, classified in class 292, subclass 241.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions in Group I and in Group II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require that the fastener has a threaded shaft and a head portion with two parts. The subcombination has separate utility such as securing two objects without the use of a support, i.e., being directly fastened to one of the objects while a part of the fastener secures the other object.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

3. If the applicant elects Group I, then this application contains claims directed to the following patentably distinct species of the claimed invention:

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- Species #1: Figures 1,4,9 and 12.
- Species #2: Figures 2,5,10 and 13.
- Species #3: Figures 3,6,11 and 14.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 23 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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4. During a telephone conversation with Mr. Donald Kettlestrings on March 15, 2005 a provisional election was made with oral traverse to prosecute the invention of Group 1, Species #2, drawn to claims 1-4,7,8,11-14,16 and 23. Applicant in replying to this Office action must make affirmation of this election. Claims 5,6,9,10,15 and 17-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

5. The drawings are objected to because:

- Figure 7, delete reference "37" that is not pointing the knurled surface (the one at the right side).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR

1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1,2,14,16, and 23 are rejected** under 35 U.S.C. 102(b) as being anticipated by US Pat No 1,414,966 to Maynard.

Regarding claim 1, Maynard discloses a system for holding together first and second objects (3 and 6 respectively).

The system comprises a first support (8) connected to and projecting from the first object (3). The first support defines at least a first opening therein.

The second object (6) is positioned adjacent to the first object (3), to the first support (8) and to the first opening (Figure 1).

The system further comprises a first fastening member (12 and 13) defining a longitudinal axis (at 12) and a first portion (at 13) substantially perpendicular to and eccentric with respect to the axis.

The first fastening member is movably positioned within the first opening and positioned with respect to the second object for enabling the first eccentric portion to

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selectively forcibly hold the second object in fixed position with respect to the first object as the first fastening member is rotated within the first opening.

The system further comprises means (at 14) in operative relationship with the first fastening member and with the first support for removeably retaining the fastening member within the first opening.

As to claim 2, Maynard illustrates that the first eccentric portion defines a substantially parabolic portion having a cross-section substantially perpendicular to the axis (Figure 3).

As to claim 14, Maynard discloses that the substantially parabolic portion defines a substantially parabolic, knurled surface (13a).

As to claim 16, Maynard illustrates that the first support (4) is substantially flat.

As to claim 23, Maynard discloses a method to holding together first and second objects (3 and 6 respectively) by means of a support (8) and a fastener (12,13 and 14).

8. **Claims 1,2,16, and 23 are rejected** under 35 U.S.C. 102(b) as being anticipated by US Pat No 1,876,115 to Way.

Regarding claim 1, Way discloses a system for holding together first and second objects (1 and 3 respectively).

The system comprises a first support (4) connected to and projecting from the first object (1). The first support defines at least a first opening therein (wherein section 15d pass through).

The second object (3) is positioned adjacent to the first object (1), to the first support (4) and to the first opening (Figure 6).

The system further comprises a first fastening member (6 and 15) defining a longitudinal axis (between 6b and 6d) and a first portion (at 15c) substantially perpendicular to and eccentric with respect to the axis.

The first fastening member is movably positioned within the first opening and positioned with respect to the second object for enabling the first eccentric portion to selectively forcibly hold the second object in fixed position with respect to the first object as the first fastening member is rotated within the first opening.

The system further comprises means (6b) in operative relationship with the first fastening member and with the first support for removeably retaining the fastening member within the first opening.

As to claim 2, Way illustrates that the first eccentric portion defines a substantially parabolic portion having a cross-section substantially perpendicular to the axis (Figure 6).

As to claim 16, Way illustrates that the first support (4) is substantially flat.

As to claim 23, Way discloses a method to holding together first and second objects (1 and 3 respectively) by means of a support (4) and a fastener (6 and 15).

9. **Claims 1-4, 16, and 23 are rejected** under 35 U.S.C. 102(b) as being anticipated by US Pat No 4,099,754 to Hoebing.

Regarding claim 1, Hoebing discloses a system for holding together first and second objects (trim piece against which the door 12 abuts, Figure 3, and 12 respectively).

The system comprises a first support (20a) connected to and projecting from the first object. The first support defines at least a first opening therein (20b).

The second object (12) is positioned adjacent to the first object (the trim piece, Figure 3), to the first support (20a) and to the first opening (20b).

The system further comprises a first fastening member (90) defining a longitudinal axis and a first portion (17,40,45 and 47) substantially perpendicular to and eccentric with respect to the axis.

The first fastening member is movably positioned within the first opening and positioned with respect to the second object for enabling the first eccentric portion to selectively forcibly hold the second object in fixed position with respect to the first object as the first fastening member is rotated within the first opening.

The system further comprises means (92) in operative relationship with the first fastening member and with the first support for removeably retaining the fastening member within the first opening.

As to claim 2, Hoebing illustrates that the first eccentric portion defines a substantially parabolic portion having a cross-section substantially perpendicular to the axis (any end portion of 17).

As to claim 3, Hoebing discloses that the fastening member (90) is a bolt having a threaded shaft and a head connected to the shaft and wherein the first eccentric portion extends from the head (Figure 3).

As to claims 4, Hoebing discloses that the retaining means includes a nut (92) threadedly engaging the threaded shaft.

As to claim 16, Hoebing illustrates that the first support (the trim piece) is substantially flat.

As to claim 23, Hoebing discloses a method to holding together first and second objects (the trim piece against which the door 12 abuts, Figure 3, and 12 respectively) by means of a support (17) and a fastener (90).

10. Claims 1,2,16, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 1,804,877 to Johnson et al (Johnson '877).

Regarding claim 1, Johnson '877 discloses a system for holding together a first object (the frame 11) with respect to a second object (the sash 10).

The system comprises a first support (4) connected to and projecting from the first object. The first support defines at least a first opening therein (where 19 is placed).

The second object (10) is positioned adjacent to the first object (11), to the first support (4) and to the first opening.

The system further comprises a first fastening member (19) defining a longitudinal axis and a first portion (18) substantially perpendicular to and eccentric with respect to the axis.

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The first fastening member is movably positioned within the first opening and positioned with respect to the second object for enabling the first eccentric portion to selectively forcibly hold the second object in fixed position with respect to the first object as the first fastening member is rotated within the first opening.

The system further comprises means (the ends of 19) in operative relationship with the first fastening member and with the first support for removeably retaining the fastening member within the first opening.

As to claim 2, Johnson '877 illustrates that the first eccentric portion (18) defines a substantially parabolic portion having a cross-section substantially perpendicular to the axis.

As to claim 16, Johnson '877 illustrates that the first support (18) is substantially flat.

As to claim 23, Johnson '877 discloses a method to holding together first and second objects (11 and 10 respectively) by means of a support (4) and a fastener (19).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claims 7,8, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 1,414,966 to Maynard as applied to claims 1 and 2 above, and further in view of US Pat No 1,876,115 to Hanny.

Regarding claims 7,8 and 13, Maynard fails to disclose that the system is used to hold a cover to an open front box. Maynard only discloses that the system is used to hold a movable closure in a closed position.

Hanny teaches that it is well known in the art to have a similar lock system to hold a cover member (12) against an open front box (10).

It would have been obvious to one having ordinary skill in the art to provide a box/cover device, as taught by Hanny, with a system to hold a movable closure, as described by Maynard, since the recitation with respect to the manner in which the system is intended to be employed does not impose any structural limitation upon the claimed apparatus, which differentiates it from a prior art reference disclosing the structural limitations of the claim.

As to claim 11, Maynard, as modified by Hanny, discloses that the system further includes at least one substantially L-shaped support (13). However, Maynard, as modified by Hanny, fails to disclose that the L-shaped support is connected to the box for supporting the cover. Way, as modified by Hanny, discloses that the L-shaped support (13) is connected to the cover so as to support the cover with respect to the box.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the L-shaped support connected to the box, instead of

being connected to the cover, since the reversal of components in a prior art reference, where there is no disclosed significance to such reversal, is a design consideration within the skill of the art.

As to claim 12, Maynard illustrates that the first support (8) is substantially flat (at least the base part of the support).

13. **Claims 7,8, and 11-13 are rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 1,876,115 to Way as applied to claims 1 and 2 above, and further in view of US Pat No 1,876,115 to Hanny.

Regarding claims 7,8 and 13, Way fails to disclose that the system is used to hold a cover to an open front box. Way only discloses that the system is used to hold a movable closure in a closed position.

Hanny teaches that it is well known in the art to have a similar lock system to hold a cover member (12) against an open front box (10).

It would have been obvious to one having ordinary skill in the art to provide a box/cover device, as taught by Hanny, with a system to hold a movable closure, as described by Way, since the recitation with respect to the manner in which the system is intended to be employed does not impose any structural limitation upon the claimed apparatus, which differentiates it from a prior art reference disclosing the structural limitations of the claim.

As to claim 11, Way, as modified by Hanny, discloses that the system further includes at least one substantially L-shaped support (13). However, Way, as modified by Hanny, fails to disclose that the L-shaped support is connected to the

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box for supporting the cover. Way, as modified by Hanny, discloses that the L-shaped support (13) is connected to the cover so as to support the cover with respect to the box.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the L-shaped support connected to the box, instead of being connected to the cover, since the reversal of components in a prior art reference, where there is no disclosed significance to such reversal, is a design consideration within the skill of the art.

As to claim 12, Way illustrates that the first support (4) is substantially flat.

14. **Claims 7,8, and 13 are rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 4,099,754 to Hoebing as applied to claims 1 and 2 above, and further in view of US Pat No 1,876,115 to Hanny.

Hoebing fails to disclose that the system is used to hold a cover to an open front box. Hoebing only discloses that the system is used to hold a movable closure in a closed position.

Hanny teaches that it is well known in the art to have a similar lock system to hold a cover member (12) against an open front box (10).

It would have been obvious to one having ordinary skill in the art to provide a box/cover device, as taught by Hanny, with a system to hold a movable closure, as described by Hoebing, since the recitation with respect to the manner in which the system is intended to be employed does not impose any structural limitation upon

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the claimed apparatus, which differentiates it from a prior art reference disclosing the structural limitations of the claim.

- 15. Claims 3 and 4 are rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 1,804,877 to Johnson et al (Johnson '877) as applied to claims 1 and 2 above, and further in view of US Pat No 4,099,754 to Hoebing.

Johnson '877 fails to disclose that the fastening member is a bolt having a threaded shaft and a head connected to the shaft and wherein the first eccentric portion extends from the head and that the retaining means includes a nut threadedly engaging the threaded shaft. Johnson '877 discloses that the fastening member (19) is a pin.

Hoebing teaches that it is well known in the art to have a fastening member (90) that is a bolt having a threaded shaft and a head connected to the shaft and that the retaining means includes a nut (92) threadedly engaging the threaded shaft.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a fastener member that is a threaded bolt in combination with a nut, as taught by Hoebing, into a device as described by Johnson '877, in order to readily remove the portion from the support.

- 16. Claims 7,8, and 13 are rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 1,804,877 to Johnson et al (Johnson '877) as applied to claims 1 and 2 above, and further in view of US Pat No 1,876,115 to Hanny.

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Johnson '877 fails to disclose that the system is used to hold a cover to an open front box. Johnson '877 only discloses that the system is used to hold a movable closure in a closed position.

Hanny teaches that it is well known in the art to have a similar lock system to hold a cover member (12) against an open front box (10).

It would have been obvious to one having ordinary skill in the art to provide a box/cover device, as taught by Hanny, with a system to hold a movable closure, as described by Johnson '877, since the recitation with respect to the manner in which the system is intended to be employed does not impose any structural limitation upon the claimed apparatus, which differentiates it from a prior art reference disclosing the structural limitations of the claim.

17. **Claim 14 is rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 1,804,877 to Johnson et al (Johnson '877) as applied to claims 1 and 2 above, and further in view of US Pat No 1,414,966 to Maynard.

Johnson '877 fails to disclose that the substantially parabolic portion defines a substantially parabolic, knurled surface.

Maynard teaches that it is well known in the art to have a portion that has a substantially parabolic portion defining a substantially parabolic, knurled surface (13a).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a knurled surface, as taught by Maynard, into a device

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as described by Johnson '877, in order to assist in the engagement between the first and second objects.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lugo whose telephone number is 703-305-9747. The examiner can normally be reached on 9-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

C.L.

Carlos Lugo
AU 3676

April 4, 2005.



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